REMARKS

In response to an Official Action dated March 22, 2006, Applicant respectfully submits the following remarks. This application contains claims 1-30, all of which were rejected in the Official Action. Reconsideration is respectfully requested in view of the remarks that follow.

Claims 1-24 and 30 were rejected under 35 U.S.C. 101 for being directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

The present rejection repeats a similar rejection made in the previous Official Action in this case. In an interview following that Official Action, Applicant's representative discussed with the Examiner how the claims could be amended in order to overcome the rejection. The Examiner advised that claims 1 and 13 should be amended so that the steps of reading contents and assigning labels recite "machine reading" and "machine assigning." The claims were amended accordingly. It is therefore distressing and disconcerting that the Examiner has now repeated the rejection notwithstanding the amendment.

It should further be pointed out that in view of the recent ruling of the Board of Patent Appeals and Interferences, *Ex parte Lundgren*, the amendment made previously was not needed for patentability of the claims.

The Examiner held that claims 1-24 and 30 are non-statutory for failing to produce a "concrete, useful, and tangible result," because "Merely assigning a label to a field... is merely an abstract idea having no real world application." This statement is itself a contradiction in terms. Field labels in a form document are not "abstract ideas," but are rather concrete indicators of the contents of the fields. The field labels have a critical "real world application" in making it possible for a reader (computerized or human) to identify and make use of the contents that have been filled into the fields. The need for field labels is clearly elucidated in the present patent application (page 1, lines 13-16):

> "Before extracting the information that has been filled into any given form, the computer must first know which field is which. Only then can the computer process the information that the form contains."

Assigning labels to fields thus provides the concrete and tangible result of identifying a field that was previously unknown, with the useful outcome that the information in the fields can thus be processed. Each label assignment refers to a particular field on a particular form. Although the process may be carried out within the memory of a computer, there is nothing abstract about it. Applicant notes parenthetically that if the Examiner's criteria for application of 35 U.S.C. 101 were to be applied to the claims in the patents cited by the Examiner as prior art in this case, those patents would evidently be invalidated, as would a large portion of the patents on computer-related inventions that the Patent Office has granted in recent years.

Thus, all of the claims in this application are believed to meet the requirements of 35 U.S.C. 101.

Claims 1-30 were rejected under 35 U.S.C. 103(a) over Rawat et al. (U.S. Patent 6,662,340) in view of Lee et al. (U.S. Patent 6,535,883), Hetherington (U.S. Patent Application Publication 2002/0010714), or Gupta et al. (U.S. Patent 6,199,079). Applicant respectfully traverses these rejections.

The present patent application was filed December 19, 2000. Rawat was filed May 30, 2002, i.e., after the filing date of the present patent application, as a continuation-in-part of U.S. Patent Application 09/561,449, filed April 28, 2000, which recently issued as U.S. Patent 6,981,028. It is therefore clear that Rawat is effective as prior art against the claims in the present patent application only to the extent that U.S. Patent 6,981,028 discloses the subject matter that is cited against the claims in the present patent application. As noted in MPEP 706.02(f)(1)(B): "The 35 U.S.C. 102(e) date of a reference... is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120 if the prior application(s) properly

supports the subject matter used to make the rejection" (emphasis added). The same criterion applies to 102(e) references that are used in rejections under 35 U.S.C. 103. In other words, any disclosure made by Rawat that does not also appear in U.S. Patent 6,981,028 is ineffective as prior art against the present patent application.

In rejecting the claims in the present patent application, the Examiner relied on descriptions in Rawat of "means for assigning labels for fields lacking a label (or tag)." The Examiner cited Rawat's abstract; col. 3, lines 30-45; and col. 7, lines 1-35, in support of the rejection. Applicant has studied U.S. Patent 6,981,028 in depth and has found no mention whatsoever of how a field lacking a label (or tag) might be handled. The substance of the passage cited by the Examiner in Rawat is absent from U.S. Patent 6,981,028. Rather, this patent assumes that field name strings are available in on-line forms. The system described in this patent compares these strings to a database of known field names in order to "map" the form and then fill in the appropriate user data (col. 15, lines 4-37). U.S. Patent 6,981,028 neither teaches nor suggests the methods described by Rawat for identifying fields that lack labels. (Evidently, Rawat and his co-inventors realized only later that there might be a problem of unlabeled fields.) In other words, U.S. Patent 6,981,028 fails to support the subject matter in Rawat that was used by the Examiner in making the present rejection. Therefore, Applicant respectfully submits that Rawat is ineffective as prior art against the present patent application.

In the absence of Rawat as a prior art reference, the rejection of claims 1-30 under 35 U.S.C. 103(a) must be withdrawn. Thus, all the claims in this application are believed to be patentable over the cited art.

Applicant believes the remarks presented hereinabove to be fully responsive to all of the grounds of rejection raised by the Examiner. In view of these remarks, Applicant respectfully submits that all of the claims in the present application are in order for allowance. Notice to this effect is hereby requested.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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